

REMARKS

Applicant thanks Examiner Randall for his careful review of the pending claims. In this Amendment and Response, Applicant has amended claims 1, 9, 20 and 27. Claim 26 has been canceled and new claim 29 has been added. Thus, claims 1, 9-11, 20-25 and 27-29 remain pending.

For at least the following reasons, the rejections of all pending claims should be withdrawn and the claims should be passed to issue. While this paper is believed to completely address all pending rejections, Applicant reserves the right to set forth other reasons supporting the patentability of the claims, including reasons supporting the separate patentability of dependent claims not explicitly addressed herein, in future papers.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

I. Drawing Objections

The drawings were objected to under 37 CFR 1.83(a). More specifically, the examiner objected to the drawings, alleging that the “first and second end” recited in new claims 26-28 were not shown in the drawing figures. Applicants respectfully disagree.

FIG. 4, for example (reproduced below for the Examiner’s convenience) clearly shows an embodiment of the bag dispensing device that includes a bag-retaining arm 26. As may be seen, the bag-retaining arm 26 has a first end and a second end. The first end of the bag retaining arm 26 is pivotally connected to the rear surface of the plate 14. Thus, the drawings do, in fact, illustrate the “first and second end” features set forth in claim 26. Accordingly, Applicants respectfully request that the objection be withdrawn.

¹ As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome any rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

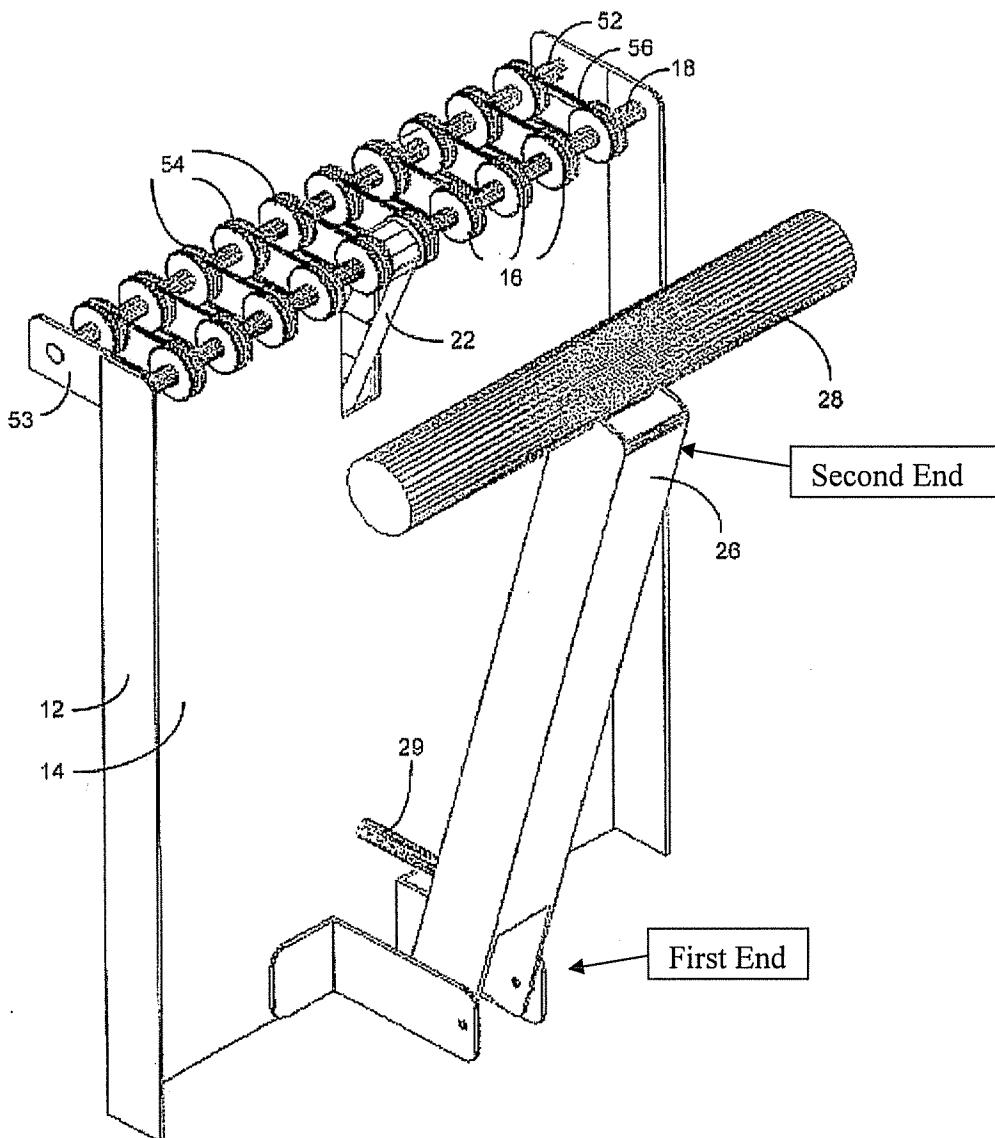


FIG. 4

II. Rejection of Claims 26, 27, and 28 Under 35 U.S.C. § 112, ¶ 2

The Examiner also rejected claims 26, 27 and 28 under 35 U.S.C. § 112, ¶ 2 for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner suggested that the specification does not adequately describe the “first and second ends” of the retaining element. Applicants respectfully disagree.

As set forth above, FIG. 4 illustrates an embodiment of the retaining element, i.e., a bag-retaining arm 26. The bag retaining arm 26 is clearly shown with a first end pivotally connected to the rear of surface of plate 14 and a second end connected to a bar 28. Indeed, paragraph [0036] specifically describes that the bag-retaining arm 26 is pivotally mounting on a rear surface of plate 14. Further, paragraph [0036] also states that “a bar 28 is mounted on the end of arm 26...” Thus, one of ordinary skill in the art reading the specification in connection with the drawings would understand that one end of the retaining element, i.e., a first end, is pivotally connected to the plate and could clearly distinguish a second end of the retaining element. Accordingly, withdrawal of the rejection is respectfully requested.

III. Rejection of Claims 1 and 19 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, Brenner, and Churchman

The Examiner rejected claims 1 and 19 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502, Schlumpf, U.S. Patent No. 4,296,873, Brenner, U.S. Patent No. 3,503,481, and Churchman, U.S. Patent No. 800,702. The rejection is respectfully traversed.

As an initial matter, claim 1 has been amended to positively recite a device for dispensing a bag from a stack of bags, the device comprising: “a plate vertically mounted on a frame, said plate defining a planar bag-supporting surface and an opposite planar surface; a rotatable shaft mounted on top of said frame; wherein the stack of bags is held against said planar bag-supporting surface, and said nearmost bag is shifted over said at least one roller and descends down along said opposite planar surface of said plate....” Support for these amendments may be found, at least on page 6, lines 8-16, page 9, line 4-page 10, line 4 and figures 1-5.

In the response to Applicant’s previous arguments with respect to claim 1, the Examiner stated that “there is no structural language within the claim that would support the Applicant’s assumption that the bag will dispense to the other side of the plate other than its intended use.” Applicant respectfully disagrees. Claim 1, as previously presented, stated “wherein the stack of bags is held against said planar bag-supporting surface, and when said rotatable shaft rotates, said nearmost bag is thereby dispensed *to said opposite planar surface side of said plate, said plate being disposed between said dispensed nearmost bags and the stack of bags . . .*” However, in an

effort to advance prosecution, Applicant has further amended claim 1 to positively recite that: . . . “said nearmost bag is shifted over said at least one roller and descends down along said opposite planar surface side of said plate . . .” This limitation is clearly not shown in Mossler.

Mossler teaches a newspaper dispensing apparatus that includes an upright partition A⁵ that separates a front compartment A² and a paper holding receptacle A’ within the housing. A discharge opening a⁶ is located on a bottom portion of paper holding receptacle A’. Rollers B¹ are positioned “adjacent the lower edge of the partition A⁵. In operation of the structure disclosed in Mossler, the newspaper is pulled down through the discharge opening a⁶ and away from the lowermost surface of the partition A⁵. However, unlike claim 1, Mossler does not disclose that an adjacent newspaper is “shifted over . . . at least one roller” as positively claimed by Applicant. Indeed, in Mossler, the newspapers only contact a portion of the roller, as the newspaper descends in a vertical direction. The newspapers are not “shifted over at least one roller” as set forth in claim 1.

Further, because the newspapers in Mossler do not move over at least one roller, the newspapers do not “descend down” along an “opposite planar surface side of said plate” as expressly recited in claim 1, as amended. In fact, the newspaper vending apparatus of Mossler actually teaches away from having the newspapers “descend down along said opposite planar surface side of said plate” as the roller B¹ is positioned directly adjacent a bottom edge of the partition A⁵ and the discharge opening a⁶ is positioned adjacent the roller such that the newspapers in Mossler are unable to descend down along the opposite planar surface side of the partition from which the newspapers are supported against.

Claim 1 has also been amended to recite that the rotatable shaft is “mounted on top of said frame.” This limitation is clearly not shown in Mossler. Indeed, the roller B¹ in Mossler is disposed along the bottom of the housing.

Nor do the remaining references, Schlumpf, Brenner, and Churchman, make up for the deficiencies of Mossler. Accordingly, claim 1 is patentably distinct over the cited art. Withdrawal of the rejection is respectfully requested. Claim 19, which includes additional limitations that separately patentable over the cited art, is also patentable merely by virtue of its dependency upon claim 1. Thus, withdrawal of the rejection with respect to claim 19 is also respectfully requested.

IV. Rejection of Claims 9-11 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, Brenner, Churchman, and Coleman

The Examiner rejected claims 9-11 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502, Schlumpf, U.S. Patent No. 4,296,873, Brenner, U.S. Patent No. 3,503,481, Churchman, U.S. Patent No. 800,702, and Coleman U.S. Patent Publication No. 2001/0032859. The rejection is also respectfully traversed.

Claims 9-11 depend either directly or indirectly from claim 1. Thus, the arguments presented above with respect to the Mossler/Schlumpf/Brenner/Churchman combination are equally applicable here. Nor does Coleman make up for the deficiencies of the Mossler/Schlumpf/Brenner/Churchman combination. Accordingly, claims 9-11 are patentable simply by virtue of their dependency upon claim 1.

However, these claims have additional limitations that are not shown in the prior art. For example, claim 9, as amended, positively recites “a second rotatable shaft mounted parallel to said rotatable shaft on ‘an extension of said frame,’ wherein said extension is attached to the frame and extends away from the plate.” Coleman does not teach, suggest or disclose these limitations. Indeed, the shafts in Coleman (73) and (75) are mounted to the same sidewalls of the housing 17, not an extension of the housing, as positively claimed by Applicant. *See* paragraph [0055]. For this separate reason, claim 9 is also patentable over the cited art.

V. Rejection of Claim 20 Under 35 U.S.C. § 103(a) Based on Mossler and Schlumpf

The Examiner rejected claim 20 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502 and Schlumpf, U.S. Patent No. 4,296,873. The rejection is respectfully traversed.

Claim 20, as amended, positively recites: “dispensing one bag from said stack of bags nearmost said planar bag-supporting surface to said opposite planar surface of said plate by rotating said rotatable shaft so as to shift said nearmost one bag over said at least one roller such that said nearmost one bag descends down along said opposite planar surface.” This limitation is clearly not shown in Mossler.

Mossler teaches a newspaper dispensing apparatus that, in operation, includes having the newspaper pulled down through the discharge opening a⁶ and away from the lowermost surface of

the partition A⁵. However, unlike claim 20, Mossler does not disclose a method whereby a rotatable shaft is rotated so as to *shift said nearmost one bag over said at least one roller such that said nearmost one bag descends down along said opposite planar surface*. Indeed, in Mossler, the rotation of the shaft B causes the newspapers to be merely dispensed downward and away from partition A⁵. The newspapers are not “shifted over at least one roller” as set forth in claim 20.

Further, the newspapers in Mossler do not “descend down” along an “opposite planar surface” of said plate as expressly recited in claim 20, as amended. In fact, the newspaper vending apparatus of Mossler actually teaches away from having the newspapers “descend down along said opposite planar surface of said plate” as the roller B¹ is positioned directly adjacent a bottom edge of the partition A⁵ and the discharge opening a⁶ is positioned adjacent the roller such that the newspapers in Mossler are unable to descend down along the opposite planar surface side of the partition from which the newspapers are supported against. Thus, Mossler fails to disclose or suggest the dispensing limitation of claim 20. Nor does Schlumpf make up for the deficiencies of Mossler. Thus, claim 20 is also allowable over the cited references. Withdrawal of the rejection is therefore requested.

VI. Rejection of Claims 21-23 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, and Brenner

The Examiner rejected claims 21-23 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502, Schlumpf, U.S. Patent No. 4,296,873, and Brenner, U.S. Patent No. 3,503,481. The rejection is respectfully traversed.

Claims 21-23 depend either directly or indirectly from claim 20. Thus, the arguments presented above with respect to the Mossler/Schlumpf combination are equally applicable here. Nor does Brenner make up for the deficiencies of Mossler and Schlumpf. Accordingly, claims 21-23 are patentable simply by virtue of their dependency upon claim 20. Withdrawal of the rejection is therefore respectfully requested.

VII. Rejection of Claims 24 and 25 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, and Coleman

The Examiner rejected claims 24 and 25 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502, Schlumpf, U.S. Patent No. 4,296,873, and Coleman, U.S. Patent Publication No. 2001/0032859. The rejection is respectfully traversed.

Claims 24-25 depend either directly or indirectly from claim 20. Thus, the arguments presented above with respect to the Mossler/Schlumpf combination are equally applicable here. Nor does Coleman make up for the deficiencies of Mossler and Schlumpf. Accordingly, claims 24-25 are patentable simply by virtue of their dependency upon claim 20. Withdrawal of the rejection is therefore respectfully requested.

VIII. Allowable Subject Matter

The Applicants thank the Examiner for the indication of allowable subject matter for claims 26-28. In accordance with the Examiner's suggestion, Applicant has rewritten claim 26 in independent form as new claim 29. Similarly, claim 27 has been amended to depend from new claim 29. Thus, claims 27 and 29 are now in condition for allowance.

Claim 28 depends from claim 20. As explained above, claim 20 is patentable over the art. Accordingly, it is also believed that claim 28 is in condition for allowance.

CONCLUSION

In view of the above amendments and remarks it is respectfully submitted that the claims are in condition for allowance. Re-examination and allowance are, therefore, respectfully solicited. In the event the Examiner deems that outstanding issues remain, he is respectfully requested to telephone the undersigned attorney in an effort to resolve such issues.

Any fee due with this response is identified in an accompanying transmittal. However, if any additional fees are due, please charge our Deposit Account No. 18-0013, under Order No. 66599-0005 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Application No. 10/580,289
Amendment dated May 10, 2010
After Final Office Action of December 14, 2009

Docket No.: 66599-0005

Dated: May 10, 2010

Respectfully submitted,

By Kristin L. Murphy/
Kristin L. Murphy
Registration No.: 41,212
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 10291
Attorney for Applicant

R0754751.DOC